

Appl. No. 10/779,337
Amdt. Dated October 23, 2007
Reply to Office Action of August 2, 2007

REMARKS

Applicants thank the Examiner for acknowledging receipt of foreign priority document, Japanese Application No. JP2003-038699, that has been submitted pursuant to 35 U.S.C. § 119 and/or PCT Rule 17.2(a).

New claims 2 - 10 have been added in order to alternately define the invention as disclosed in the specification.

Applicants respectfully request reconsideration of the Examiner's rejection of claim 1 under 35 U.S.C. §103(a). The Examiner has rejected these claims in view of the cited references of *Uchida* (USPN 6,767,697) in view of *Nishikawa* (USPPN 2004/0076083) and further in view of *Miyaoka* (USPN 6,716,489).

Applicants submit that the cited references of record fail to support a prima facie case of obviousness for at least the reasons that the references fail to disclose each and every limitation of the claims, and that there is no teaching, suggestion, or motivation to combine the references. Furthermore, Applicants submit that even if there was such a motivation to combine, the resultant combination would not anticipate the current claims.

First and foremost, Applicants submit that the Examiner has failed to set forth any disclosure, teaching, or suggestion regarding the application of two separate and distinct annealing steps, wherein in a first annealing step, only the sidewalls between the grooves and the lands are irradiated, and a second annealing step, in which the sidewalls and the lands are irradiated.

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Rather, the Examiner merely cites two references that separately disclose a single annealing step, and appears to state that it would have been obvious to execute these two annealing steps in succession. The Examiner fails to provide any citation to the art, or any reasoning as to why one of ordinary skill in the art would have been motivated to do so in light of these two references. Rather, the Examiner states on page 3, lines 14 – 16 of the last Office Action that “The motivation for utilizing the features of Nishikawa is that it allows for modifying the magnetism and thereby magnetically parting the adjacent grooves.”

However, the method of Uchida has already accomplished that. There is no reason to apply a second anneal of Nishikawa in light of that fact, and accordingly, the Examiner's motivation to combine necessarily fails.

Additionally, Applicants note that the portion of the Uchida reference cited by the Examiner (Column 9, lines 26 – 39) is directed to an alternate DWD arrangement in which information is stored on both the grooves 42 and the lands 41 (See Fig. 4 of Uchida). The anneal of the sidewalls only delinks / demagnetizes the sidewalls and allows for recording of data on these two spaces 41 and 42. Applicants note that the application of any additional annealing of the lands 41 (as set forth in Nishikawa) would prevent the recordation of data on the lands, counter to the disclosure and purpose of the structure set forth in Column 9, lines 26 – 39 and Fig.'s 4 and 5 of Uchida. Applicants note that the CAFC has held that “We have noted elsewhere, as a ‘useful general rule,’ that references that teach away cannot serve to create a prima facie case of obviousness.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir.,

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2001). Here, Uchida teaches away from the application of an anneal of the lands 41 by disclosing and teaching that the lands should be used as a recording layer.

Furthermore, there is no disclosure, teaching, or suggestion that a first of the anneals should not include a magnetization, and that a second of the anneals should include a magnetization. Rather, Miyaoka merely discloses an anneal with magnetization.

In summary, Applicants submit that one of ordinary skill in the art, in light of all of the references cited by the Examiner, would, at most, be motivated to apply a single annealing step of sidewalls (Uchida) or lands (Nishikawa), utilizing no magnetization (Uchida) or magnetization (Miyaoka). There is absolutely no support or evidence that one of ordinary skill in the art would have combined the references as asserted by the Examiner.

The Examiner's remaining references cited but not relied upon, considered either alone or in combination, also fail to teach applicant's currently claimed invention. In light of the foregoing, Applicants respectfully submit that all claims now stand in condition for allowance.

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In the event that it is deemed necessary, the Commissioner is hereby
authorized to charge any fees due or to credit any overpayment to Deposit
Account No. 50-3891.

Respectfully submitted,

Date: 12/3/07
#37,607)



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